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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/925,375 | 08/10/2001 | Ryuji Kohno | 501.40205X00 | 4453 |

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| EXAMINER | |
|---|---|
| NGUYEN, TRUNG Q | |
| **ART UNIT** | **PAPER NUMBER** |
| 2829 | |

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/925,375 | Applicant(s) KOHNO ET AL. | |
|---|---|---|---|
| | Examiner Trung Q Nguyen | Art Unit 2829 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *24 July 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,2,6,8,11 and 14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,6,8,11 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Drawings*

1. Figures 15-18 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-2, 6, 8 11 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanamaru et al. (U.S. 6,531,327).

Regarding claim 1, Kanamaru et al. disclose in Figures 2, 10, 12 and 16D a plurality of beams supported 27 of Fig. 16D (not shown in Fig. 10), by support portions

of a substrate 4 of Figs. 2 and 10, wherein probes 6 are formed on beams (portion of E shape around probe 6 of Fig. 10); and first lines via 12 of Fig. 12 to connect probes 6 of Fig. 10 to secondary electrodes 3b of Fig. 12 formed on substrate 4 and second lines via 21 of Fig. 12 to connect beams 6 of Fig. 10 to support portions, wherein first and second lines 21 of Fig. 12 are formed on beams.

Regarding claim 2, Kanamaru et al. disclose in Figures 2 and 10 a plurality of double-supported beam (see Fig. 2) by support portions of a substrate 4 of Figs. 2 and 10, wherein probes 6 are formed on beams (portion of E shape around probe 6 of Fig. 10); and lines 7 and 21 of Fig. 2 to connect probes 6 of Figs. 2 and 10 to secondary electrodes 3b of Fig. 2 and 10 formed on substrate, wherein line is formed on one of double-support beams 7 of Fig. 2 and extends from both sides of one of probes 6 on a face of beam where probe is formed (see Fig. 2).

Regarding claim 6, Kanamaru et al. disclose in Figure 2 a plurality of double-supported beam (see Fig. 2) by support portions of a silicon substrate 4; probes 6 that are projection 10 (column 5, lines 1-3) are formed on beams (portion of E shape around probe 6 of Fig. 10); and wiring lines 7 of Fig. 2 to connect probes 6 of Figs. 2 and 10 to secondary electrodes 3b of Fig. 2 and 10 formed on substrate, wherein line is formed on one of double-support beams 7 of Fig. 2 and extends from both sides of one of probes 6 on a face of beam where probe is formed (see Fig. 2).

Regarding claim 8, Kanamaru et al. disclose in column 6, lines 10-15 a probe formed on one of beams is distanced from and adjacent probe formed on an adjacent beam by 100micro meter or less.

Regarding claims 11 and 14, Kanamaru et al. disclose in column 2, lines 23-29, an initial defect accelerated selection test process and a final performance test process obtained by cutting a wafer (by means cutting of wasting a wafer); the test process is executed by the apparatus that Kanamaru et al. disclose in Figure 2 a plurality of double-supported beam (see Fig. 2) by support portions of a silicon substrate 4; probes 6 that are projection 10 (column 5, lines 1-3) are formed on beams (portion of E shape around probe 6 of Fig. 10); and wiring lines 7 of Fig. 2 to connect probes 6 of Figs. 2 and 10 to secondary electrodes 3b of Fig. 2 and 10 formed on substrate, wherein line is formed on one of double-support beams 7 of Fig. 2 and extends from both sides of one of probes 6 on a face of beam where probe is formed (see Fig. 2).

***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trung Nguyen whose telephone number is 703-305-4925. The examiner can normally be reached on Monday through Friday, 8:30AM – 5:00PM. The fax numbers for the organization where this application or proceeding is assigned are (703) 872-9306. If attempts to reach the examiner by telephone are

unsuccessful, the examiner's supervisor, Cuneo Kamand can be reached at (703) 308-1233.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0956.

*Trung Nguyen*
Patent Examiner
Group Art Unit 2829
September 19, 2003

KAMAND CUNEO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800